



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,353	03/26/2001	Philip S. Siegel	067439-0111	4525
5073	7590	11/19/2008		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER SHAAWAT, MUSSA A	
			ART UNIT	PAPER NUMBER
			3627	
			NOTIFICATION DATE	DELIVERY MODE
			11/19/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com
glenda.orrantia@bakerbotts.com

Office Action Summary

Application No.

09/817,353

Applicant(s)

SIEGEL, PHILIP S.

Examiner

MUSSA A. SHAAWAT

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 10-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 35-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

1. This action is in response to advisory action filed on 11/04/2008. **Applicant's arguments are persuasive, as a result the previous final rejection will be withdrawn and a second final herein will be mailed out.** Claims 1, 8, 41 and 46 have been amended (see amendment filed on 06/19/2008). Claims 10-34 have been previously withdrawn. Claims 1-9 and 35-46 are pending examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-6, 9, 35-41 and 44-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright et al, US Patent No. (6,980,962) referred to hereinafter as Arganbright in view of Cybul et al., US Patent No. (6,246,997) referred to hereinafter as Cybul.

As per claim 1, Arganbright teaches a method for processing the returns of merchandise purchased through the World Wide Web comprising: receiving from a consumer an electronic request via a computerized system associated with the consumer, the electronic request requesting to initiate processing of one or more items of merchandise purchased by the consumer in a prior purchase transaction (see at least col.62 line 65-col.63 line 10); and in response to receiving the electronic selection of particular item or merchandise, initiating a returns process for the particular item of

merchandise chosen by the consumer, the return process initiated by return server (see at least col.63 lines 8-11).

Arganbright does not expressly teach in response to receiving the electronic request from the computing system associated with the consumer gathering transaction history data associated with the consumer from a computerized database; displaying the transaction history associated with the identified consumer to the consumer on the computerized system associated with the consumer, the transaction history identifying a listing of merchandise associated with the consumer; in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise.

However Cybul teaches accessing or gathering previous shopping history or transaction history data associated with a consumer from a computerized database (see at least Abstract, and col.4 lines 40-50); displaying the previous transaction or shopping history via a web browser interface where the previous shopping history is associated with the consumer (see at least col.3 line 65-col.4 lines 15); in response to displaying the transaction history associated with the consumer, receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer

selecting previous shopping history). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cybul into the disclosure of Arganbright in order to provide the consumer with the option to return items via internet or online.

As per claim 2, Arganbright teaches a method of Claim 1 further comprising retrieving a preference profile for the identified consumer (see col. 62 lines 43-45)

As per claim 4, Arganbright teaches a method of Claim 1 further comprising notifying a retailer associated with the item selected by the consumer (see col.63 lines 8-11)

As per claim 5, Arganbright teaches a method of Claim 4 further comprising providing the retailer with the transaction information and consumer information associated with the item selected by the consumer (see col. 63 lines 8-11)

As per claim 6, Arganbright teaches a method of Claim 1 further comprising generating a return shipping label for the merchandise to be returned (col. 63 lines 23-30)

As per claim 9, Arganbright teaches a method of Claim 1 further comprising communicating between a client system and a server system via the Internet (see col. 63 lines 1-11).

As per claim 37, Arganbright teaches a method of Claim 1, wherein identifying the consumer comprises identifying the consumer using a login process (see col. 48 lines 50-65).

As per claim 38, Arganbright teaches a method of Claim 37, further comprising requesting transaction history data from a retailer on a real-time basis upon identifying the consumer using the login process (see at least col. 62 lines 42-45).

As per claim 39, Arganbright teaches a method of Claim 1, further comprising receiving transaction history data from a retailer on a periodic basis (see at least col. 48 lines 1-65).

As per claim 35, Arganbright teaches a method of Claim 2, further comprising completing the returns process based upon settings in the consumer preference profile (see col. 62 lines 42-45, and col. 63 lines 1-20).

As per claim 36, Arganbright teaches a method of Claim 2, wherein the consumer preference profile comprises a name associated with the consumer, credit information associated with the consumer, and shipping information associated with the consumer (col. 62 lines 42-45, and col. 63 lines 1-20, and col. 71 lines 9-10).

As per claim 40, Arganbright teaches a method of Claim 1, wherein the listing of merchandise in the transaction history is indicative of merchandise purchased by the consumer from an e-tailer (see at least col. 48 lines 1-65, col.62 lines 30-50).

As per claim 41, Arganbright teaches a method of Claim 1, wherein identifying the consumer comprises receiving a client system identifier in a message from the consumer (see col. 48 lines 1-65).

As per claim 44, Arganbright teaches a method of Claim 1, wherein initiating the return process comprises determining if the selected item of merchandise is perishable (see col. 63 lines 10-20).

As per claim 45, Arganbright teaches a method of Claim 1, wherein initiating the return process comprises using the computerized system associated with the consumer to generate a return shipping label to be used to return the selected item (see col. 63 lines 10-35).

As per Claims 46, the limitations of claim 46 are similar to the limitations of claim 1, therefore it is rejected based on the same rationale

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 7-8 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Cybul in further view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) and official notice.

As per claim 8, Arganbright in view of teaches all the limitations of claim 8, except for auctioning the merchandise selected for return by the consumer. However, Roman teaches returns disposition including resale of product returns via auction over the internet (see at least Para [0003]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul in order to minimize the loss of revenues of the merchant.

As per claim 3, Arganbright in view of Cybul does not expressly teach crediting a consumer account indicated in the consumer preference profile based upon the item selected. However Roman teaches crediting a consumer's account (see at least Para [0017]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul, for the convenience of the consumer and consumer satisfaction.

As per claim 7, Although Arganbright in view of Cybul teaches printing a shipping label in conjunction with United States Postal Service for Example, Arganbright does not expressly teach notifying a shipping provider of a merchandise return to be picked up. However Roman teaches notifying a shipping provider to pick up the merchandise (see at least Para [0020]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul in order to provide the customer with an added convenience.

RE: Claim 42, Arganbright in view of Cybul does not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul in order to prevent the invalid return of merchandise.

RE: Claim 43: Arganbright in view of Cybul does not expressly teach comparing information associated with the selection of the item of merchandise to at least one return rule of a retailer associated with the transaction. However Roman teaches an e-tailer establishes parameter e.g. rules to determining whether the return is valid, see pp 0016 Roman et al. It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in view of Cybul the motivation being the same as in claim 10.

Response to Arguments

6. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Contact information

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUSSA A. SHAAWAT whose telephone number is (571)272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mussa A Shaawat/
Examiner, Art Unit 3627
November 15, 2008

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627